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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/026,966 | 12/19/2001 | David Bebbington | VPI/00-130-06 | 1800 |

7590 08/15/2003

Tina Powers
VERTEX PHARMACEUTICALS INC.
130 Waverly Street
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[REDACTED] EXAMINER

HABTE, KAH SAY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1624 | |

DATE MAILED: 08/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------|---------------------|
| Office Action Summary | Application N | Applicant(s) |
| | 10/026,966 | BEBBINGTON ET AL. |
| | Examiner | Art Unit |
| | Kahsay Habte, Ph. D. | 1624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 8/04/03.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13,15,16,18,19,22,24 and 26-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-13,15,16,18,19,22,24 and 26-29 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Claims 1-13, 15-16, 18-19, 22, 24, and 26-29 are pending.
2. The reply filed on 8/04/03 is not fully responsive to the prior Office Action because of the following matter(s): applicants have amended claim 1 and switched their invention from Group I to Group II.

Response to arguments

3. Applicants' arguments filed 08/04/2003 have been fully considered but they are not persuasive.

Applicants argue: "the claim as originally filed, is directed only to those compounds where either Z¹ or Z², but not both, is N, and thus the claims of present application are only directed to those compounds of Group II." The examiner disagrees with applicants for the following reasons:

- a. Claim 1 originally read "one of Z¹ or Z² is nitrogen" indicates that at least one of Z¹ or Z² is nitrogen that covers Group I and Group II and also the situation that only one of Z¹ or Z² is nitrogen (Group II). A claim language should be given its fullest and broadest meaning. Thus, the claim as originally filed are drawn to pyrimidines (Group I) and to pyridines (Group II). Applicant's amendment of claim 1 to read "one and only one of Z¹ or Z² is nitrogen" is clearly drawn to Group II, but claim language that is narrower in scope was not present as the claims were originally filed.

b. The fact that applicants elected Group I on March 24, 2003 indicates that Z¹ and Z² can be both nitrogens (Group I) or only one of Z¹ or Z² is nitrogen (Group II).

According to 37 CFR § 1.145, applicants cannot switch their invention.

37 CFR § 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

The timely submission under 37 CFR 1.129(a) filed on 8/04/03 is not fully responsive to the prior Office action because applicants have amended claim 1 and switched their invention from Group I to Group II. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Conclusion

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Art Unit: 1624

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahl Say Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Kahl Say Habte, Ph. D.
Examiner
Art Unit 1624


Mark L. Berch
Primary Examiner
Art Unit 1624

KH
August 14, 2003